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09/981,358	10/15/2001	Stephen Lange Ranzini	3892-4002	6886

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EXAMINER
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GREENE, DANIEL L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/981,358

Applicant(s)

RANZINI ET AL.

Examiner

Daniel L. Greene

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.                      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Applicant's arguments filed 12/15/03 have been fully considered but they are not persuasive. The Applicant submits that "descriptive data" as defined in proceeding dependent claims renders the independent claims, 1, 5, 20, and 23 unique, nonobvious and original. The Examiner disagrees and sites the following two examples as why further defining a generic term in an independent claim by a dependent claim does not impart patentability. A reference is to be considered for not only for what it expressly states, but also for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969) and, It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 1, 5, 20, and 23 disclose descriptive data relating to said representation of money. The Applicant asserts that Anderson provides counterevidence and then proceeds to detail the data that Anderson provides relating to an electronic check. The Examiner maintains his original rejection in that an electronic check as described by Anderson is in fact descriptive data relating to said representation of money.

In reference to independent claims 15 and 26, the Applicant argues that "request for other descriptive data" and "memorandum of a proposed transaction 66" is not one in the same. The Examiner submits that Anderson's "memorandum of a proposed transaction 66" contains by it's very nature "request for other descriptive data". The Applicant appears to arguing that if the phrases and or words are not the

same, the concept would be different. As previously shown, a reference is to be considered for not only for what it expressly states, but also for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969) and, It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Anderson discloses the concepts of electronic checks and request for information as previously detailed out in the last Office Action.

In reference to independent claims 8 and 10 and 15 and 29, the Applicant disregards the concepts presented by the references and designated by the Examiner and makes no attempt to modify their claims to teach around the references. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987)

1. The Applicant asserts that the Examiner's remarks concerning claims 1,5,16,20,23,26, and 72 suggest various limitations are "inherent" in claims where they are not stated has been noted. Unfortunately, the Applicant does not justify his assertion with the facts, as he perceives them, thus not providing the Examiner a format or data on which to respond.

**2. The Examiner includes a modified previous Response to Arguments to further amplify and illustrate the art and logic that the Applicant is required to address and to amend their claims to negate the art cited.**

3. The Applicant submits as per independent claims 1 and 20, that the references cited fail to disclose, teach, or suggest "...further placing in said container descriptive data relating to said representation of money...". As per Anderson '739, paragraph [0175], the reference teaches about electronically creating an electronic check which by its very nature is descriptive data relating to representation of money.

4. The Applicant further submits that as per independent claims 5 and 23, that the references cited fail to disclose, teach, or suggest "... interfacing with software for producing descriptive data ... [and] ... placing in said container descriptive data produced by said software..." As per Anderson '739 and Ginter '140 the patents and their described inventions are computer based which by their very nature are software ran/dependent to function. It is intuitively obvious that all computers require software/programs to function, and software to produce descriptive data will provide descriptive data produced by said hardware.

5. The Applicant further submits that as per independent claims 16 and 26, that the references cited fail to disclose, teach, or suggest " ... placing in said container descriptive data relating to said representation of money ... [and] ... further placing in said container a request for other descriptive data ..." As per Anderson '739, paragraph [0175], the reference teaches about electronically creating an electronic check which by its very nature is descriptive data relating to representation of money. Anderson '739

Art Unit: 3621

further teaches [0175], electronically generating a memorandum of a proposed transaction. A memorandum of a proposed transaction is inherently obvious a request for other descriptive data. I.e. acceptants, révision, etc.

6. The Applicant request that each of the claims, 1,5,16,20,23,26, and 72, be considered in the terms of that which it states. The Examiner submits that restricting the breadth of a claim by adding additional limitations can in fact render it allowable. However, when the additional limitations are implicit in the original claim, i.e. interfacing with software for producing descriptive data (5), transmitting said container as an attachment to an electronic mail message (16), a processor operatively connected to said memory for carrying out instructions ...(23 and 26), may further describe the obvious but does not provide adequate new limitations to render allowability. In reference to claim 72, Anderson '739 teaches different transportation means, such as Internet and e-mail. [0188]

7. The Applicant further submits that as per independent claims 4, and 19 that the references cited fail to disclose, teach, or suggest "... permission to submit ... predetermined authentication data ...". Both Anderson '739 and Ginter '140 describe transactions utilizing authentication protocols which requires requesting and receiving permission to submit predetermined authentication data, i.e. keys, digital signatures, etc., the art of encryption and authentication is well known and described in both of the references.

8. The Applicant further submits that as per independent claims 15 and 29, that the references cited fail to disclose, teach, or suggest "having a first party and a second

Art Unit: 3621

party exchange negotiation digital rights management containers attached to electronic mail messages in order to negotiate the information each party is willing to have used for authentication purposes ... [and] ... having said first party send to the first party's clearing bank a first permission digital rights management container attached to an electronic mail message, said first permission container granting said first clearing bank permission to submit to said second party the information said first party agreed to supply in the negotiation ..." Anderson '739 teaches about authentication protocols and bank transactions, [0225-0236] . Anderson '736 further discloses application needs per each party and their respective qualifications and protocols.

*Claims 1-106 are pending in the Application without amendments.*

### **Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over

US 20010018739A1-Anderson et al. [ Anderson '739 ], and further in view of US 6,427,140-Ginter et al. [ Ginter '140 ]

3. As per claims 1,5,16,20,23, 26 and 72.

Claims 1,5,16,20,23, 26 and 72 each have the same three (3) specific limitations;  
placing in a digital rights management container a digital representation of money;  
further placing in said container descriptive data relating to said representation of money  
and transmitting said container as an attachment to an electronic mail message.

As per *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951), it has been held that a preamble is denied the effect of a limitation where the portion of the claim following the preamble is a self-contained description. In the cases of the aforementioned claims, the limitations are in fact self-contained descriptions of sufficient substance to convey the intent of the application. Therefore 1,5,16,20,23 and 26 will be addressed as all being one in the same.

Anderson '739 disclose:

placing in a digital rights management container a digital representation of money; Fig. 3  
0175.

further placing in said container descriptive data relating to said representation of money; Fig. 3  
0174-0175.

and transmitting said container as an attachment to an electronic mail message. Fig. 3, 0  
0175.

Anderson '739 discloses the claimed invention except for the digital rights management container. Ginter '140 teaches that it is known to utilize the concept of placing data into a VIDE content container/digital rights management container and associating control information with s data. It would have been obvious to one having ordinary skill in the art at the time the invention made to utilize a VIDE content container/digital rights management container as taught by Ginte



`140, since Ginter `140 states at Col. 22, lines 15-25 that such a modification would eliminate the constraints of having to use a few high level individual, pre-defined content provider increments

As per claims 2,3,6,7,17,18,21,22,24,25,27,28,56,57,58 and 97-99.

Claims 2,3,6,7,17,18,21,22,24,25,27,28,56,57,58 and 97-99 each have the specific limitations of;

wherein the descriptive data is ...

Anderson `739 discloses the claimed invention, as discussed above, except for the descriptive data being "enterprise resource planning and govt. research" It would have been an obvious modification design choice to modify the teachings of Anderson `739, to provide the title for descriptive data as enterprise resource planning and or govt. research, etc. In fact, Anderson `739 discloses the manner in which language/description data can be medical record, contract, prescription, transcript, etc. Since the applicant has not disclosed that the descriptive data being "enterprise resource planning and govt. research" solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Anderson `739 will perform the invention as claimed by the applicant with any method, means, or product to generate descriptive data be it "enterprise resource planning and govt. research" or any other title for descriptive data

As per claims 8-12,49-55,59-62,92-96,100 and 101.

Claims 8-12,49-55,59-62,92-96,100 and 101 each have the general limitation of;  
performing a settlement using a bank payment system .

Anderson `739 discloses the claimed invention, as discussed above, for performing a settlement using a bank payment system. It would have been an obvious matter of design choice to modify the teachings of Anderson `739 and Ginter `140 to provide performing a settlement using a bank payment system regardless of the terms used to describe the same action/entity be it, a firm entity or customer or user, etc, be it using an ATM POS system, interfacing with a currency exchange provider, a conventional bank, performed in an automated manner etc. Since the applicant has disclosed that using different names to describe the same thing solves any stated problem in a novel or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill in the art appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Anderson `739 and Ginter `140 will perform the invention as claimed by the applicant with any method, means, or product to perform a settlement using a bank payment system.

As per claims 4,13-15,19,29-31,63-68,74,102-104.

Claims 4,13-15,19,29-31,63-68,74,102-104 each has the general limitation of;

performing authentication and the terminology utilized by Anderson `739 [00730075] and Ginter `140 Fig. 10, Col. 8, lines 1-10 and Col. 67, lines 1-50,

Anderson `739 and Ginter `140 discloses the claimed invention including, determining the identity of the requestor, the authority of the requestor, predetermined rules, open standard cryptographic method, avoiding fraud, selecting the authentication method, etc. It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform authentication protocols such as determining the identity of the requestor, authority of the requestor,

Art Unit: 3621

predetermined rules, open standard cryptographic method, avoiding fraud, selecting the authentication method, etc. Anderson `739 Fig. 17 A/B and Ginter `140 Fig. 10.

As per claims 32-43 and 76-86 each has the limitation of; ... accessing databases.

Anderson `739 further discloses the claimed invention except for accessing the database are identified by synergistic services, aliases of users, validation services, etc. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [ 0252].

As per claims 44-48, 75, 87-91 each has the limitation of; ... providing customer service.

Anderson `739 discloses the claimed invention except for the providing customer service. Ginter `140 teaches that it is known to provide customer service. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide customer service as taught by Ginter `140, since Ginter `140 states at Col. 26, lines 35-67 that such a modification would support user interaction.

As per claims 69-71, 105 and 106 each has the limitation of; ... screening e-mail

Anderson `739 discloses the claimed invention except for screening e-mail. It would have been obvious to one having ordinary skill in the art at the time the invention was made to screen e-mail since it was known in the art that screening e-mail prevents incursions of viruses and Spam mail.

As per claim 73.

Anderson `739 discloses the claimed invention except for software is voice activated. Ginter `140 teaches that it is known to utilize voice-activated software. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use voice-activated software taught by Ginter `140, since Ginter `140 shows in Fig. 7, 613, a voice recognition device and that such a modification would provide another form of data entry by the user.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### **Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3621

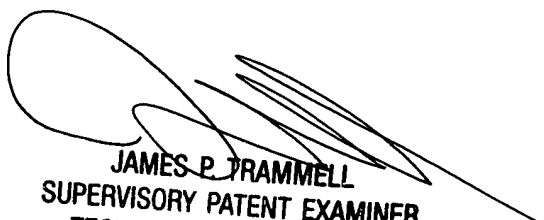
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703.306.5539. The examiner can normally be reached on M-Thurs. (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703.305.9768. The fax phone numbers for the organization where this application or proceeding is assigned is 703.305-7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308-1113.

DLG January 27, 2004

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
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